

REMARKS

Applicants respectfully traverse the Notice of Non-Compliant Amendment mailed 3/10/04. The Notice checked box 4a that states, "A complete listing of all of the claims is not present." Applicants respectfully submit that the response to the Office Action did include a complete listing of all of the claims. Thus, the Notice of Non-Compliant amendment was improper. Nonetheless, in an effort to expedite prosecution of this case, applicants submit the present response. Applicant reserves the right to request additional patent term in light of this traversal.

The Office Action rejected claims 10 and 11 under 35 U.S.C. Section 112, second paragraph.

Applicants regret the obvious typographical error in claim 11 and apologize for any inconvenience to the Examiner. The last paragraph is deleted. Also, explicit antecedent basis is provided for "predetermined amount".

With respect to claim 10, this claim has been amended for clarity purposes. It is respectfully submitted that both claims 10 and 11 have not been narrowed in scope. The present amendments merely make explicit what was already inherent or merely correct clear typographical errors or other informalities.

The Examiner is respectfully thanked for granting an interview to the undersigned attorney on January 21, 2004. At the interview, applicant's attorney showed the Examiner a sample of a device that is capable of drilling holes in bone and passing a suture therebetween without requiring the device to be removed from the region of the suture passage until after the suture is passed. This is believed to offer significant advantages for a surgeon, especially one who seeks to place a suture in bone at a remote location. The advantages of the present invention were discussed relative to the prior art. The Examiner is respectfully thanked for the helpful suggestions during the interview.

The Office Action rejected claims 15-19 under 35 U.S.C. Section 102 (b) as being anticipated by Romano, U.S. Pat. No. 5,509,918. Claims 20-28 were rejected under 35 U.S.C. Section 102 (b) as being anticipated by Sohn PCT WO/97/47246. Claims 1-4, 10 and 11 were rejected under 35 U.S.C. Section 103 (a) as being unpatenable over Romano in view of Sohn.

Claims 1-4 are herein cancelled without prejudice. All cancelled claims in this case are cancelled without prejudice to applicant's right to file a continuing application. Independent claims 10, 11, 15, 20 and 23 are currently pending.

With respect to claims 10 and 11, it is agreed that Romano does not teach a needle. Sohn is cited for supporting the teaching of a needle. Neither Romano nor Sohn disclose the needle retractor of claim 10. Neither Romano nor Sohn disclose the needle advancer of claim 11. Embodiments of these features are described (not to be limited thereto) at, for example, page 15 of the present specification.

With respect to claim 10, the Office Action took the position that elements 100, 102, 182 and 244 of Romano constitute a needle retractor. We respectfully disagree. Romano discloses a push rod 100, a push rod 102, push bar 182 and push line 244. None of these elements constitute a needle retractor, nor do they meet the limitations of claim 10. For example, claim 10 sets forth "a needle retractor, which retracts said needle when the force on said handle is lower than a predetermined amount, prior to said base retreating from said bone region in response to a lowering of the force below the predetermined amount." This element of the claim is not disclosed in Romano. The Office Action references columns 6-9, lines 1-67. Applicants have reviewed these passages and do not find this limitation therein. Thus, the rejection of claim 10 should be withdrawn.

With respect to claim 11, the Office Action took the position that elements 100, 102, 182 and 244 of Romano constituted a cutting bit advancer and that the disclosure in columns 6-9, lines 1-67 anticipates claim 11. We respectfully disagree. Romano discloses a push rod 100, a push rod 102, push bar 182 and push line 244. None of these elements meet the limitations of claim 11, either alone or in combination. For example, claim 11 sets forth "a needle advancer, which advances said needle only when a force on said handle in a particular direction is higher than a predetermined amount, said predetermined amount assuring that said base is urged against said bone." This limitation is not disclosed or suggested in Romano. The Office Action references columns 6-9, lines 1-67. Applicants have reviewed these passages of Romano and do not find this limitation therein. Thus, the rejection of claim 11 should be withdrawn.

The Office Action took the position that elements 242 and 246 of Romano were “hinges” in the context of claim 15. Romano does disclose pivot pins 242 and 246. However, neither of these elements comprises a hinge in the context of claim 15. Claim 15 sets forth:

A self-aligning device for boring into bone, comprising:

a boring head having at least two boring tips;

a body;

a handle attached to said body; and

a hinge coupling said boring head to said body at a location substantially equidistant from said boring tips.

The invention set forth in claim 15 promotes uses where a substantially equal force is applied to the boring tips. Romano teaches the *opposite*. In Romano, to avoid interference between the linkage and damage to the two cutting bits 240 that would occur if they contacted each other, left clip 104 is retracted from its maximum displaced position (Fig. 2B), *before* right clip 116 is advanced to a point of maximum displacement (Fig. 2C). See column 7, lines 48-53. Thus, the rejection of claim 15 based on Romano should be withdrawn.

Claims 20 is a method claim. The Office Action stated that the method steps would “inherently” be carried out in the operation of the device. Applicants respectfully disagree.

Romano teaches boring a hole with a first, bone boring device and *using a second, curved surgical needle with a stitch to embed the stitch in the hole bored by the first device*. See column 1, lines 20-22. The device of Romano is incapable of performing the claimed method. A limitation is inherent if it is the natural result flowing from the explicit disclosure of Romano. *Eli Lilly v. Barr Labs., Inc.*, 251 F.3d 955, 970 (Fed. Cir. 2001). Certainly a device that is incapable of performing a claimed invention cannot anticipate the claim. The Office Action does not explain how the method steps are the natural result of the explicit disclosure of Romano. Thus, the rejection of claim 20 should be withdrawn.

With respect to claim 23, it is respectfully submitted that original claim 23 is novel and patentable over Sohn. However, in order to expedite prosecution of the present case, this claim has been amended to claim an invention that is clearly not taught in Sohn. Nor is it obvious in view of Sohn.


Examination and reconsideration of the application as amended is requested. Support for this amendment is clearly found in the application as originally filed. No new matter is presented.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested. Allowance of the pending claims at an early date is solicited.

No fee is believed due for the submission of this amendment. A supplemental information disclosure statement was mailed on February 19, 2004. A transmittal sheet accompanies this amendment. Please charge to Deposit Account No 501921 the fees for the timely submission of these documents.

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Respectfully submitted,

Signature

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